

This Page Is Inserted by IFW Operations  
and is not a part of the Official Record

## **BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning documents *will not* correct images,  
please do not report the images to the  
Image Problem Mailbox.**

### REMARKS

Reconsideration of the Office Action dated April 22, 2004, is respectfully requested in view of the attached translation and for at least the reasons which follow.

Applicant acknowledges that claims 1 and 3-20 are pending in this application. Applicant also acknowledges with appreciation the indication that claims 7, 8 and 14 are drawn to allowable subject matter.

Turning to the Office Action, claims 1, 3-6, 9, 12, 16 and 18-20 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,983,498 to Rode et al. with U.S. Patent No. 6,364,544 to Sasayama et al. being cited to support the Examiner's inherency position with respect to electric conductivity of the developing solutions of the Rode et al. '498 patent. The Examiner's rationale is set forth in paragraph (5) of the Office Action. Reconsideration and withdrawal of this rejection are requested in view of the following comments.

The only developer solution disclosed in Rode et al. '498 is described in column 12, lines 12-19: sodium metasilicate · 9H<sub>2</sub>O, 2.13 pbw strontium chloride, 1.2 pbw polyoxyethylene ether nonionic wetting agent, 0.12 pbw antifoamer, and 4000 pbw water. Note that the amount of sodium metasilicate is not disclosed. The quantity of inorganic alkali agent affects the pH and conductivity of the developer solution; note the discussion on page 8 of the present specification and column 4, lines 52-55 of Sasayama et al. '544. In the absence of a disclosure in Rode et al. '498 of the amount of sodium metasilicate present in the developer, it is not clear how one could determine the pH and conductivity of the solution.

The Office Action relies on Sasayama et al. '544 to sustain the argument that the developer disclosed in Rode et al. '498 inherently possesses a pH and conductivity within the ranges of the rejected claims. The Action opines that the conductivity of the developer of Rode et al. "498 must be in the range of 2-40 mS/cm. because Sasayama et al. '544 teaches that a silicate-type processing agent exhibits a conductivity of 55 mS/cm after plate processing so the initial conductivity must have been in the 2-40 range.

Respectfully, Applicant disagrees. This conclusion is mere conjecture. One could just as easily conclude that the initial conductivity of the silicate-type developer was 45 or 50 as opposed to 40 or below.

To support a rejection based on inherency, the Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the disclosures of the prior art. It is well established that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result of characteristic." In re Rijckaert, 9 F.3d 1531,1534, 38 U.S.P.Q.2d 1955,1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' In re Robertson, 169 F.3d 743,745, 49 U.S.P.Q.2d 1949,1950-51 (Fed. Cir. 1999)." "In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows

from the teachings of the applied prior art.” Ex parte Levy, 17 U.S.P.Q.2d 1461,1464 (Bd. Of Pat. Apps. & Inter. 1990).” Note M.P.E.P. §2112.

Thus, inherency must flow as a necessary conclusion from the prior art, not simply a possible one. Applicants respectfully submit that there is no basis in fact and/or technical reasoning to reasonably support a conclusion that the allegedly inherent characteristic (i.e. pH and conductivity) necessarily flows from the disclosure of the reference.

Attached to the present Response is a verified translation of the Japanese priority application, Serial No. JP 2000-315393, filed October 16, 2000. The disclosure in the translated document fully supports the presently claimed invention and establishes an effective filing date of October 16, 2000. This date is prior to the January 31, 2001, filing date of Sasayama et al. '544. Accordingly, this patent cannot be used as a reference to support any prior art rejection.

For at least the above reasons, the §102(b) rejection based on Rode et al. '498 in view of the teachings of Sasayama et al. '544 should be withdrawn. Such action is earnestly requested.

Claims 1, 3, 5, 9-13, 15, 16 and 18-20 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,514,668 to Tsuji et al. with Sasayama et al. '544 again being relied upon to support the inherency rejection. The Examiner's reasons are set forth in paragraph (6) of the Office Action. Reconsideration and withdrawal of this rejection are respectfully requested for at least the reasons which follow.

For a proper anticipation rejection, a reference must disclose the claimed invention without any need “for picking, choosing and combining various disclosures not directly related to each other by the teachings of the cited reference.” In re

Arkley, 455 F.2d 586,587; 172 U.S.P.Q. 524,526 (C.C.P.A. 1972). In order to arrive at the method recited in present claim 1, one would need to prepare a photosensitive composition by selecting a compound having a nitrogen atom and an ethylenically unsaturated double bond from the lengthy list of suitable compounds disclosed in columns 3 and 4 of Tsuji et al. '668; and prepare a developer containing an alkali agent from the list in column 13, line 60 to column 14, line 3, a polyoxyethylene nonionic surfactant from the list of suitable compounds in column 14, lines 3-10, and fortuitously combine them in amounts sufficient to yield a pH and conductivity within the ranges of claim 1.

Thus, the §102(e) rejection based on Tsuji et al. '668 relies heavily on "picking, choosing and combining various disclosures not directly related to each other by the teachings of the cited reference." It is noted that the developer solution specifically disclosed in this reference (column 17, lines 25-27 and column 16, lines 58-60) does not contain a nonionic surfactant, let alone one having a polyoxyalkylene ether group.

Even if one applies the teachings of Sasayama et al. '544 to the disclosure of Tsuji et al. '668, the resultant method would not be anticipatory due to the aforementioned deficiencies in the disclosure of Tsuji et al. '668. Moreover, Sasayama et al. '544 is unavailable as a teaching reference since the patent has been antedated for reasons discussed previously.

For at least the above reasons, the §102(e) rejection based on Tsuji et al. '668 combined with Sasayama et al. '544 should be reconsidered and withdrawn. Such action is respectfully requested.

Claim 17 stands rejected under 35 U.S.C. §103(a) as unpatentable over Rode et al. '498 or Tsuji et al. '668, each in view of U.S. Patent No. 6,558,875 to Toshimitsu et al. with Sasayama et al. '544 cited to support the theory of inherency for the reasons given in paragraphs (9) and (10) of the Office Action. Reconsideration and withdrawal of these rejections are requested for at least the following reasons.

The combined disclosures of Rode et al. '498 or Tsuji et al. '668 with Sasayama et al. '544 fail to disclose a method of making a lithographic printing plate using a developing solution containing an inorganic alkali agent and a nonionic surface active agent having a polyoxyalkylene ether group and having a pH in the range of 9 to 13.5 and an electric conductivity in the range of 2 to 40 mS/cm for the reasons fully set forth above. Toshimitsu et al. '875 is relied upon solely to suggest the addition of surfactant to the photopolymerizable composition. As such, it does not supply the aforementioned deficiencies in the basic combination of references.

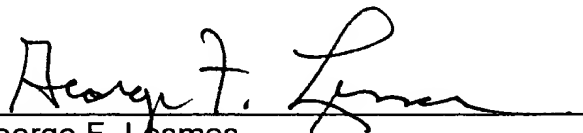
Accordingly, the §103(a) rejections of claim 17 should be withdrawn and such action is respectfully requested.

From the foregoing, further and favorable action in the form of Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at his earliest convenience.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: July 19, 2004

By:   
George F. Lesmes  
Registration No. 19,995

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620